

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proudnikov et al in view of Ekenberg '531.

The Applicant reiterates its request for clarification as to the status of remaining claims 26-27.

A terminal disclaimer is enclosed herewith, executed by the undersigned. Also enclosed are 3.73(b) statements related to the two properties commonly owned by the Assignee The University of Chicago.

In light of the foregoing, Applicants respectfully request that the double patent rejection be withdrawn.

As to the 103(a) rejections, Applicant submits the following remarks:

Mirzabekov Neither Anticipates Nor
Suggests Radical Mediated Processes

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirzabekov et al (U.S. Patent No. 5,981,734) in view of Ekenberg '531. The Examiner states that Mirzabekov uses radical based chemistry. Applicants respectfully disagree.

Nowhere in the Mirzabekov patent is a radical mediated process anticipated or suggested. Whereas, aldehyde derivatives of nucleic acids are generated in the instant method using radicals, Mirzabekov relies on acids. Specifically, the Applicants invite the Examiner to review Mirzabekov's FIG. 1. FIG 1 shows DNA depurination and aldehyde production facilitated with formic- or hydrochloric-acid via a mechanism of proton adsorption with nucleobase. FIG. 2 of Mirzabekov demonstrates aldehyde production after RNA oxidation with sodium periodate. Intermediate this reaction exists a cyclic ether of periodate acid. No radicals exist at anytime in Mirzabekov's processes. This is why Mirzabekov's process requires hours to complete (See Column 6, lines 37-67, and Column 7, lines 1-60).

The instant method enables DNA *and* RNA production of aldehyde derivatives of nucleic acids. This production occurs via hydrogen radical excision from deoxyribose or ribose residues. The instant radical-based process is completed in a matter of minutes.

In light of the foregoing, Applicants request that the 103(a) rejection based on

Mirzabekov and Ekenberg be withdrawn and that claims 1-25 be allowed.

Proudnikov-Ekenberg Rejection
Previously Successfully Traversed

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proudnikov et al in view of Ekenberg '531. This rejection is identical to that found in the June 3, 2002 Official Action. The record reflects successful traversal of that rejection. (See Applicant's August 5, 2002 response.)

In light of the foregoing, the Applicants request withdrawal of the 103(a) rejection based on Proudnikov et al in view of Ekenberg and allowance of claims 1-25

An earnest attempt has been made hereby to respond to the §103 rejections contained in this fourth, nonfinal Official Action. It is submitted that all remaining claims are of proper form and scope for allowance. If the Examiner feels that a telephonic interview would expedite prosecution of this application, she is respectfully urged to contact the undersigned prior to the issuance of another official action. Reconsideration and allowance of claims 1-25, and clarification as to the status of claims 26-27, is respectfully solicited.

Respectfully submitted,

CHERSKOV & FLAYNIK

 

Michael J. Cherskov (Reg No. 33,664)